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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Ronaldus H. T. Oosterholt et al. ATTNY DOCKET NO.: PHN17,871  
SERIAL NO. : 09/741,926 EXAMINER : Peng Ke  
FILED : December 20, 2000 ART UNIT : 2174  
FOR : DEVICE FOR PRESENTING INFORMATION UNITS

REPLY BRIEF TRANSMITTAL LETTER

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Dear Sir:

Appellants respectfully submit three copies of a Reply Brief For Appellants that includes an Appendix with the pending claims. The Reply Brief is now due on August 28, 2006.

Should the Examiner deem that there are any issues which may be best resolved by telephone communication, kindly telephone Applicants undersigned representative at the number listed below.

Respectfully submitted,  
Daniel Piotrowski  
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By: *Steve Callahan*  
Attorney for Applicant  
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Date: August 28, 2006

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Lorraine Callahan  
(Print Name)

*Lorraine Callahan 8/28/06*  
(Signature and Date)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

**In re the Application**

**Inventor** : Ronaldus Hermanus Theordorus Oosterholt et al.  
**Application No.** : 09/741,926  
**Filed** : December 20, 2000  
**For** : DEVICE FOR PRESENTING INFORMATION UNITS

**REPLY BRIEF**

On Appeal from Group Art Unit 2174

**Daniel Piotrowski**  
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By: Steve Cha  
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Registration No. 44,069

**Date: August 28, 2006**

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Lorraine Callahan  
(Print Name )

  
(Signature and Date)

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**I. REAL PARTY IN INTEREST**

Reference is made to the Appeal Brief and Examiner's Answer.

**II. RELATED APPEALS AND INTERFERENCES**

Reference is made to the Appeal Brief and Examiner's Answer.

**III. STATUS OF CLAIMS**

Reference is made to the Appeal Brief and Examiner's Answer.

**IV. STATUS OF AMENDMENTS**

Reference is made to the Appeal Brief and Examiner's Answer.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

Reference is made to the Appeal Brief and Examiner's Answer.

**VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL**

Reference is made to the Appeal Brief and Examiner's Answer and repeated herein:

1. Claims 1-14 are rendered obvious under 35 USC §103(a) by the combination of Horvitz and Kulkarni.

## VII. ARGUMENT

### **I. Rejection of claims 1-14 Under 35 USC §103(a) in view of Horvitz and Kulkarni**

In response to the arguments provided in the Examiner's Answer dated June 28, 2006, Applicant respectfully submits that the Answer fails to show that the combined device discloses all the elements claimed even if there were some motivation to combine the teachings of the cited references.

The Answer maintains the reason for the rejection of the claims in stating that "Horvitz teaches a device for presenting information units, comprising history means for storing references to presentable information units into a history list, the history means comprising user operable navigation means for changing a current position in the history list (col. 40, lines 1-63). Examiner infers that the history list is a container that contains a list of the web pages, which are previously viewed by the user. Horvitz allows the user to view the pre-fetched web pages, and that would change the position of the web pages that were previously viewed by the user and presentation means for presenting an information unit referenced by the reference at the current position, and compilation means for user operably compiling a set of reference to desired information units, wherein the compiled set of references includes both previously viewed and un-viewed information units (col. 40, lines 1-30) and storing the references of said set into the history list so as to present an information referenced by the compiled set in response to a user operating said navigation means (col. 34, lines 19-46) ... Kulkarni teaches storing the references of said set according to the time of their inclusion (col. 6, lines 45-50)" (see Answer, pages 3-4).

The rejection of the claims is in error as the inference of maintaining a history list by Horvitz is not valid and even if it could be said that Horvitz does maintains a history

list, the maintained history list does not include "both previously viewed and un-viewed information units.

Horvitz teaches a technique for prefetching a web page of potential future interest that may be subsequently selected by the user or that contain content that may be of future interest to the user based upon current and/or prior interaction of the user. Horvitz teaches development a probabilistic or statistical user model used to prefetch information including, for example, web pages, wherein when viewing a first web page, the user probabilistic model interprets the links on the currently viewed web page and downloads information associated with the most-likely links of interest to the user based on the user model. The construction and updating of the probabilistic user model is based on factors such as "content and structure of [a] particular web page, *a history of web pages visited* by the user, [the] user background and user actions" (see Horvitz, col. 1, lines 20-22) (emphasis added). "The user model can rely on, e.g., a function(s) of current page structure and content, recent sequences of pages downloaded to the user, descriptions of long-term or short-term interest of the user, user background, the behavior of the user in interacting with the computer or previously downloaded content and one or more usage statistics available from a server or from the user's computer." (see Horvitz, col. 4, lines 10-17).

Furthermore, Horvitz discloses "[a]s successive web pages are selected by the user and displayed, the user model is updated through consideration of the current page; thereafter new pages may be prefetched and so on." (see Horvitz, col. 9, lines 4-6).

As Horvitz fails to disclose storing the references that are used to refine the model, the inference that a history list of viewed and unviewed web pages is in error.

Horvitz is silent with regard to maintaining a list of previously viewed and unviewed pages as Horvitz describes using the information of previously viewed web pages to update and refine the user model. This silence is apparent as the Examiner must infer the existence of the history list, without any specific teaching of Horvitz to describe such a list.

Even if it could be said that the Horvitz were to maintain a history list, the history list maintained by Horvitz includes only viewed pages as only the viewed pages are needed for updating the model. Horvitz specifically discloses the transit nature of unviewed web pages, in stating that "[w]hen limits are reached in local memory, based on memory allocated for prefetching content cached earlier prefetched pages can be overwritten by files for a current set of prefetched pages, where the least valuable pages are targeted for replacement (see col. 9, lines 7-10).

Hence, Horvitz fails to provide any teaching for storing unviewed web pages in a history list that has been inferred by the Examiner to exist in the teachings of Horvitz.

As noted above, Kulkarni teaches storing the references according to the time of their inclusion. Kulkarni is silent with regard to storing unviewed pages.

It is respectfully submitted that it was held by *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) that in order to establish a *prima facie* case of obviousness, three basic criteria must be met;

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

With regard to the subject matter recited in the independent claims 1 and 7, it respectfully submits that at least one of the three basic criteria for obviousness has not been met. Thus a *prima facie* case of obviousness has not been set forth.

For at least the above reasons and for the arguments presented in the Appeal Brief, which are reasserted, as if in full, herein, it is respectfully submitted that the subject matter recited in the claims is not rendered obvious by the references cited.

Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,

Daniel J. Piotrowski  
Registration No. 42,079

Date: August 28, 2006

  
By: Steve Cha  
Attorney for Applicant  
Registration No. 44,069

**VIII. CLAIMS APPENDIX**

Reference is made to the Appeal Brief and Examiner's Answer.

**IX. EVIDENCE APPENDIX**

Reference is made to the Appeal Brief and Examiner's Answer.

**X. RELATED PROCEEDING APPENDIX**

Reference is made to the Appeal Brief and Examiner's Answer.